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### **REMARKS**

This response fully addresses the issues raised in the aforementioned Office action. A detailed discussion of each issue is provided in the sections that follow.

#### **Support for Claim Amendment**

Support for the amendment of Claim 1 to include the limitations in original Claims 2 and 4 is found in the original claims.

#### **Double Patenting**

The Examiner provisionally rejected Claims 23 through 38 as claiming the same invention as that of Claims 1 through 16 of co-pending Application No. 10/179,696 (Docket No. 8618C). It is believed that no response to this provisional rejection is necessary. If a response is necessary, it is requested that the need for such a response be clarified and that an opportunity to provide such a response be provided.

#### **Claim Rejections Under 35 U.S.C. § 102/103**

In paragraph 6 of the present Office action, Claims 1 through 3, 8 through 10, 14, 16, 17 and 20 were rejected under 35 USC 102(b) and 35 USC 103(a) as being anticipated by or, in the alternative, obvious over U.S. Patent 4,690,681 to Haunschild *et al.*

The cancellation of Claim 2 has obviated its rejection.

#### **Lack of Anticipation**

Claim 1 has been amended in this response to include the limitation that the outer leg cuff is wrapped over at least one of the portions of one of the side edges defining one of the leg openings. The Examiner wrote in paragraph 12 of the previous Office action that "Haunschild *et al.*...do not specify if the outer leg cuffs are wrapped over a portion of the side edge". Therefore, the Haunschild *et al.* reference fails to teach each and every element of Claim 1 as amended and does not anticipate this claim. Furthermore, because Claims 3, 8 through 10, and 14 depend from and thereby contain all of the limitations of Claim 1, the reference likewise does not anticipate these claims.

Claim 16 contains the limitation that the claimed absorbent article has a fastening system. However, as the Examiner noted in the statement of rejection, the Haunschild *et al.* reference discloses a pre-closed article. *i.e.*, an article having no fastening system. Therefore, the Haunschild *et al.* reference fails to teach each and every element of Claim 16 and does not anticipate this claim. Furthermore, because

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Claims 17 and 20 depend from and thereby contain all of the limitations of Claim 16, the reference likewise does not anticipate these claims.

#### Lack of Obviousness

Applicants' agent respectfully traverses the rejections under 35 USC 103(a) on the ground that the Examiner has not met the requirements of MPEP § 2143 for the establishment of a *prima facie* case of obviousness. According to MPEP 2143, to establish a *prima facie* case of obviousness, three basic criteria must be met:

- there must be some suggestion or motivation to modify the reference or to combine reference teachings,
- there must be a reasonable expectation of success, and
- the prior art reference (or references when combined) must teach or suggest all the claim limitations.

As noted above, the Haunschild *et al.* reference fails to teach or suggest all the claim limitations of any of the rejected claims. Applicants' agent notes that the Examiner has proposed no modification of the reference teachings. Therefore, applicants' agent is unable to address the other two requirements of MPEP 2143.

Accordingly, applicants' agent respectfully requests that the Examiner reconsider and withdraw the rejections of Claims 1, 3, 8 through 10, 14, 16, 17, and 20 under 35 USC 102(b) and 103(a).

#### **Claim Rejections Under 35 U.S.C. § 103**

##### First Rejection Under 35 USC 103

In paragraph 8 of the present Office action, Claims 4 through 6, 15, 21, and 22 were rejected under 35 USC 103(a) as being unpatentable over the same Haunschild *et al.* reference in view of U.S. Patent 5,797,824 to Tracy. The Examiner proposed providing "the absorbent article as disclosed by Haunschild *et al.* with the discrete leg cuff structure as taught by Tracy, due to the increased ease of manufacturing the article as multiple discrete elements."

The cancellation of Claim 4 has obviated its rejection.

Applicants' agent respectfully traverses the rejections of Claims 5, 6, 15, 21, and 22 on the ground that the Examiner has not met the requirements of MPEP § 2143 for the establishment of a *prima facie* case of obviousness.

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Neither of the cited references provides any suggestion or motivation to modify the reference or to combine reference teachings. In fact, the Examiner has provided no evidence of any suggestion or motivation to modify either of the references or to combine their teachings, except a personal perspective formed with the benefit of impermissible hindsight after learning of the applicants' invention. With regard to the reason stated by the Examiner, it is respectfully pointed out that it is well known to those of skill in the art of manufacturing absorbent articles that combining multiple discrete elements is not necessarily easier, but often more difficult and less efficient than combining fewer elements, even integrated or united elements, to make the articles. Therefore, the lack of any suggestion or motivation in the references, themselves, is not remedied by the Examiner's suggestion of a reason.

Also, the Tracy reference fails to disclose anything whatsoever regarding elastics or elastically extensible leg opening margins or outer leg cuffs. Instead, the reference repeatedly describes the "soft padding member" as "strips of soft pliable material, such as cotton and the like" (column 1, lines 37 and 38), "strips of soft material, such as cotton and the like" (column 1, line 48), "soft material in the form of a strip of cotton" (column 2, lines 32 and 33), and "strips 64, 66 of a soft material, such as cotton" (column 2, line 51). The substitution of this cuff structure of the Tracy reference for the elastic leg structure of the Haunschild *et al.* reference would create a panty-like garment with non-extensible cotton strips at the leg openings and, thus, would make the garment unsuitable for the intended use described in the Haunschild *et al.* reference. Therefore, there is no reasonable expectation of success of the proposed modification.

Finally, the substitution of the cuff structure of the Tracy reference for the elastic leg structure of the Haunschild *et al.* reference would create a panty-like garment with non-extensible cotton strips at the leg openings, not an article having the highly extensible leg opening margins of the present invention. Therefore, the proposed combination of the references would fail to teach or suggest all the limitations of the rejected claims.

Furthermore, applicants' agent respectfully points out that the Examiner stated that the Tracy reference discloses "straight discrete leg cuffs (64, 66)". Because Claim 15 describes the cuff as a "curved discrete outer leg cuff", the Examiner's statement obviates the rejection of this claim.

In addition, Claim 22 depends from Claim 16 and so includes a fastening system. Thus, the Examiner's statement in paragraph 6 of the present Office action that the Haunschild *et al.* reference discloses "a pre-closed absorbent article", i.e., an article having no fastening system, obviates the rejection of this claim.

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Accordingly, applicants' agent respectfully requests that the Examiner reconsider and withdraw the rejections of Claims 5, 6, 15, 21, and 22 under 35 USC 103(a).

Second Rejection Under 35 USC 103

In paragraph 9 of the present Office action, Claims 7, 23, 27, 31, and 35 were rejected under 35 USC 103(a) as being unpatentable over the same Haunschild *et al.* reference cited in the above rejections, in view of PCT Publication WO 99/60971 to Ashton *et al.* The Examiner proposed providing "the disclosed absorbent article of Haunschild *et al.*, with a laminate leg cuff as taught by Ashton *et al.*, to improve resistance to leakage and allow for increased stretching during movement."

Applicants' agent respectfully traverses the rejections on the ground that the Examiner has not met the requirements of MPEP § 2143 for the establishment of a *prima facie* case of obviousness.

Neither of the cited references provides any suggestion or motivation to modify the reference or to combine reference teachings. In fact, the Examiner has provided no evidence of any suggestion or motivation to modify either of the references or to combine their teachings, except a personal perspective formed with the benefit of impermissible hindsight after learning of the applicants' invention. Therefore, the lack of any suggestion or motivation in the references, themselves, is not remedied by the Examiner's suggestion of a reason.

The Ashton *et al.* reference, while describing the use of a laminate for structural elements such as the backsheet and the side panels, and while describing in detail the embodiments of the elasticized leg cuffs suitable "for reducing the leakage of body exudates in the leg region", never teaches or suggests the use of a laminate for the leg cuffs. The Examiner tacitly acknowledged this fact in stating that "Ashton *et al.* ...teach that many components of absorbent articles are generally made with a laminate", without reference to any specific teaching regarding the leg cuffs. In fact, the teaching in the Ashton *et al.* reference relating to laminate structures is limited to tissue laminates in an absorbent core, laminates of nonwovens and impervious films in the backsheet, and laminates of nonwovens and elastic members in the side panels. Thus, the Examiner's reference to "a laminate leg cuff as taught by Ashton *et al.*" is without meaning, because this reference does not teach a laminate leg cuff. Therefore, the cited references fail to teach or suggest all the limitations of the rejected claims.

In addition, Claims 7 and 23 depend from Claim 1 as amended and so include a wrapped outer leg cuff. However, neither of the cited references teaches or suggests a wrapped cuff. Also, Claim 23 includes an

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incrementally stretched laminate, which neither of the references teaches using for outer leg cuffs. Therefore, these references fail to teach or suggest all the limitations of these claims.

Claim 27 depends from Claim 16 and so includes a fastening system. However, both of the cited references disclose pre-closed absorbent articles, i.e., articles having no fastening system. Also, Claim 27 includes an incrementally stretched laminate, which neither of the references teaches using for outer leg cuffs. Therefore, these references fail to teach or suggest all the limitations of this claim.

Claim 31 includes an incrementally stretched laminate, which neither of the references teaches using for outer leg cuffs. Therefore, these references fail to teach or suggest all the limitations of this claim.

Claim 35 includes an incrementally stretched laminate, which neither of the references teaches using for outer leg cuffs. Therefore, these references fail to teach or suggest all the limitations of this claim.

Accordingly, applicants' agent respectfully requests that the Examiner reconsider and withdraw the rejections of Claims 7, 23, 27, 31, and 35 under 35 USC 103(a).

#### Third Rejection Under 35 USC 103

In paragraph 10 of the present Office action, Claims 11, 12, and 18 were rejected under 35 USC 103(a) as being unpatentable over the same Haunschild *et al.* reference cited in the above rejections. The Examiner stated that "it would have been obvious...to make the...article of Haunschild *et al.* with three portions of differing elastic extensibility...due to the fact that mere duplication of the essential working parts of a device involves only routine skill in the art."

Applicants' agent respectfully traverses the rejections on the ground that the Examiner has not met the requirements of MPEP § 2143 for the establishment of a *prima facie* case of obviousness.

The provision of three portions of the leg opening margin having differential elastic extensibility is not "mere duplication". The term "duplication" means "the act or process of duplicating", and "duplicate" means "to make a copy of" or "to produce something equal to", according to the Merriam-Webster® on-line dictionary. For instance, replicating the absorbent article, itself, i.e., duplicating the absorbent article, would be duplication. However, providing three portions, with each portion having an elastic extensibility different from that of either of the other two portions, is not duplication, because none of the three portions is a duplicate of another portion. This relationship is clearly described on page 6 of the

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specification, immediately following the paragraph in which the terms "differential" and "differential properties" are defined.

The cited reference provides no suggestion or motivation to modify the reference. In fact, the Examiner has provided no evidence of any suggestion or motivation to modify the reference, except a personal perspective formed with the benefit of impermissible hindsight after learning of the applicants' invention. The Haunschild *et al.* reference, while describing the elastic legs suitable for the panty-like garment, never teaches or suggests the desirability of three portions having three elastic extensibilities. Therefore, the lack of any suggestion or motivation in the reference, itself, is not remedied by the Examiner's suggestion of a reason.

In addition, Claims 11 and 12 depend from Claim 1 as amended and so include a wrapped outer leg cuff. As stated by the Examiner in the previous Office action and as noted above, the cited reference fails to "specify if the outer leg cuffs are wrapped over a portion of the side edge". Therefore, this reference fails to teach or suggest all the limitations of these claims.

Claim 18 depends from Claim 16 and so includes a fastening system. Thus, the Examiner's statement in paragraph 6 of the present Office action that the Haunschild *et al.* reference discloses "a pre-closed absorbent article", i.e., an article having no fastening system, obviates the rejection of this claim.

Accordingly, applicants' agent respectfully requests that the Examiner reconsider and withdraw the rejections of Claims 11, 12, and 18 under 35 USC 103(a).

#### Fourth Rejection Under 35 USC 103

In paragraph 11 of the present Office action, Claims 13 and 19 were rejected under 35 USC 103(a) as being unpatentable over the same Haunschild *et al.* reference cited in the above rejections. The Examiner stated that "it would have been obvious...to have provided the leg openings with an orientation angle of 30 degrees, since it has been held that discovering an optimum value for a result effective variable involves only routine skill in the art."

Applicants' agent respectfully traverses the rejections on the ground that the Examiner has not met the requirements of MPEP § 2143 for the establishment of a *prima facie* case of obviousness.

The provision of an absorbent article that can be laterally extended to such an extent that the orientation angle is 30 degrees or less is not merely the discovery of an optimum value for a result effective variable.

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Instead, the limitation in the rejected claims is a specific description of the structure of the article, *i.e.*, it is a way of describing the claimed article.

The cited reference provides no suggestion or motivation to modify the reference. In fact, the Examiner has provided no evidence of any suggestion or motivation to modify the reference, except a personal perspective formed with the benefit of impermissible hindsight after learning of the applicants' invention. The Haunschild *et al.* reference, while describing the elastic legs suitable for the panty-like garment, never teaches or suggests a recognition of the benefit of providing an orientation angle of 30 degrees or less.

In addition, Claim 13 depends from Claim 1 as amended and so includes a wrapped outer leg cuff. As stated by the Examiner in the previous Office action and as noted above, the cited reference fails to "specify if the outer leg cuffs are wrapped over a portion of the side edge". Therefore, this reference fails to teach or suggest all the limitations of this claim.

Claim 19 depends from Claim 16 and so includes a fastening system. Thus, the Examiner's statement in paragraph 6 of the present Office action that the Haunschild *et al.* reference discloses "a pre-closed absorbent article", *i.e.*, an article having no fastening system, obviates the rejection of this claim.

Accordingly, applicants' agent respectfully requests that the Examiner reconsider and withdraw the rejections of Claims 13 and 19 under 35 USC 103(a).

#### Fifth Rejection Under 35 USC 103

In paragraph 12 of the present Office action, Claims 24 through 26, 28 through 30, 32 through 34, and 36 through 38 were rejected under 35 USC 103(a) as being unpatentable over the same Haunschild *et al.* reference cited in the above rejections, in view of the same Ashton *et al.* reference cited above, and in view of the same Tracy reference cited above. The Examiner stated that the first two listed references disclose the absorbent article previously described in paragraph 9 of the Office action. The Examiner also stated that it "would have been obvious...to have provided the absorbent article as disclosed by [the first two listed reference] with leg cuffs having a free edge disposed adjacent the inner surface of the absorbent article and a portion of the cuff in continuous alignment with the back sheet, to improve ease of manufacture of the article."

Applicants' agent respectfully traverses the rejections on the ground that the Examiner has not met the requirements of MPEP § 2143 for the establishment of a *prima facie* case of obviousness.

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Prior to discussing the rejections in detail, applicants' agent respectfully submits that the Examiner has misread the limitation in Claims 26, 30, 34, and 38 regarding a portion of the outer leg cuff being "continuous with the backsheet". As clearly described on page 9 of the specification, the term "continuous" is used in its dictionary meaning of "marked by uninterrupted extension in space" as the opposite in meaning of the term "discrete", whose dictionary definition is "consisting of distinct or unconnected elements" (both from the Merriam-Webster® on-line dictionary). The text on page 9 includes the following clear distinction between the two terms:

The term "discrete" refers herein to an element of the diaper 20 which is formed separately and distinctly from any other element and is joined to another element or elements of the diaper 20, every component of the discrete element being wholly contained within the discrete element and no component of the discrete element being continuous with an element outside the discrete element. For example, a leg cuff formed of a portion of a continuous topsheet is not discrete, while a leg cuff formed of separate and distinct pieces and joined to a topsheet may be discrete. (Underlining added for emphasis.)

Thus, it is clear that the limitation that a portion of the outer leg cuff is "continuous with the backsheet" means that this portion of the outer leg cuff is formed by an uninterrupted extension of the backsheet, rather than being formed separately and distinctly by elements that are distinct from or unconnected to the backsheet. In simple terms, this portion of the outer leg cuff and the backsheet are continuous, that is, extend uninterruptedly and "look like" a single continuous sheet or layer of material.

However, the Examiner has first stated that the Tracy reference discloses "discrete leg cuffs (64, 66)", thereby using the term "discrete" in exactly the same way as this term is used in the specification and claims of the subject application. Then, the Examiner has added the word "alignment" to the term "continuous" to create the term "continuous alignment" and has then stated that the Tracy reference discloses a portion of its cuff "in continuous alignment with the back sheet". Because the term created by the Examiner has a completely different meaning from that of the claim term, the rejections based on the created term are improper, as will be discussed in greater detail below. In addition, the Examiner's use of the created term in suggesting a reason for modifying or combining the references is without meaning, in light of the misreading of the claim limitation, i.e., the latter half of the Examiner's suggested reason does not apply to the claimed invention.



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None of the cited references provides any suggestion or motivation to modify the reference or to combine reference teachings. In fact, the Examiner has provided no evidence of any suggestion or motivation to modify any of the references or to combine their teachings, except a personal perspective formed with the benefit of impermissible hindsight after learning of the applicants' invention. For instance, neither the Haunschild et al. reference nor the Ashton et al. reference teaches or suggests the desirability of a wrapped outer leg cuff and the Tracy reference neither teaches nor suggests the desirability of an elastically extensible leg cuff. With regard to the reason stated by the Examiner, it is respectfully pointed out that it is well known to those of skill in the art of manufacturing absorbent articles that disposing a free edge of a folded or wrapped layer adjacent to an inner surface is not necessarily easier than leaving a layer unfolded or unwrapped. Therefore, the lack of any suggestion or motivation in the references, themselves, is not remedied by the Examiner's suggestion of a reason.

In addition, Claims 24, 25, and 26 depend from Claim 23 and so include an incrementally stretched laminate, which none of the references teaches using for outer leg cuffs. Also, as noted above, the Tracy reference fails to disclose anything whatsoever regarding elastics or elastically extensible leg opening margins or elastically extensible outer leg cuffs. Furthermore, none of the cited references, including the Tracy reference, as noted above, discloses a wrapped outer leg cuff that is continuous with the backsheet. Therefore, these references fail to teach or suggest all the limitations of these claims.

Claims 28, 29, and 30 depend from Claim 16 and so include a fastening system. Not only is a fastening system not taught or suggested in the first two listed references, but the incorporation of one into the articles of these two references would render them unsuitable for their intended purposes, thus eliminating any reasonable expectation of success of such a combination of elements. In other words, although the Tracy reference discloses a fastening system, the first two listed references teach away from the incorporation of one.

Claims 32, 33, and 34 depend from Claim 31 and so include an incrementally stretched laminate, which none of the references teaches using for outer leg cuffs. Also, none of the cited references, including the Tracy reference, as noted above, discloses a wrapped outer leg cuff that is continuous with the backsheet. Therefore, these references fail to teach or suggest all the limitations of these claims.

Claims 36, 37, and 38 depend from Claim 35 and so include an incrementally stretched laminate, which none of the references teaches using for outer leg cuffs. Also, none of the cited references, including the Tracy reference, as noted above, discloses a wrapped outer leg cuff that is continuous with the backsheet. Therefore, these references fail to teach or suggest all the limitations of these claims.

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Accordingly, applicants' agent respectfully requests that the Examiner reconsider and withdraw the rejections of Claims 24 through 26, 28 through 30, 32 through 34, and 36 through 38 under 35 USC 103(a).

**Summary of this Response**

No new matter has been added in this response. In light of the above amendments and remarks, applicants request that the Examiner reconsider and withdraw the rejections and allow the pending claims. The issuance of a Notice of Allowance at an early date is respectfully requested.

Respectfully submitted,

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20 May 2003

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